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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,097	02/24/2004	William P. O'Donnell	45054.00.058	8794

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EXAMINER

LE, MARK T

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,097

Applicant(s)

O'DONNELL ET AL.

Examiner

Mark T. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-25 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 26-30 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/5/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 8-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, last line, the expression "... said walled enclosure by said spring" is not clear.

2. In claim 18, there must be a period at the end of the claim.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 8-12, 16, 18-25 and 33-34 (8-12 as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Geyer (US 3,707,927).

Geyer discloses a constant contact side bearing assembly having all the features recited in the instant claims, including spring 13, housing or body member 6, and cap or friction member 8.

Regarding the instant claimed intended use for insertion into a walled receptacle, note that since the structure of Geyer is inherently capable of the instant claimed intended use, i.e. for insertion into a walled receptacle that is large enough to receive the body member of Geyer, the limitation of the instant claimed intended use is considered met.

Regarding the instant claimed apparatus or spacer, as recited e.g. in claims 4 and 11, for locating the side bearing assembly, it is considered that flange 4 extending from the bottom of body member 6 of Geyer is readable as such apparatus or spacer.

Regarding the instant claimed housing and cap being configured to dissipate heat, as recited in claims 22-23, note that the housing and cap of Geyer are inherently capable of dissipating heat, i.e. heat dissipation by conduction through the material of the housing and the cap.

Regarding the instant claimed wall structure of the housing and the cap being configured to promote the movement of air through the cavity of the housing and away from the spring, as recited in claim 25, note that in the structure of Geyer, air may move away from the spring through the bottom opening of housing 6.

5. Claims 17 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geyer (US 3,707,927).

Geyer is applied above.

Regarding the instant claimed height of the housing being between about 2.5 inches to about 4.5 inches, it is noted that Geyer does not disclose the height of his bearing assembly or the housing thereof; however, one skilled in the art would realize that the degree of flexibility of the bearing assembly of Geyer would inherently correspond to the height of the spring and the housing thereof. Accordingly, it would have been obvious to one skilled in the art to make the spring and the housing of the structure of Geyer at a desired height, such as between about 2.5 inches to about 4.5 inches, so as to achieve the expected corresponding degree of flexibility of the bearing

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assembly. On the other hand, since Geyer does not specify the height of his bearing assembly or the housing thereof, it would have been obvious to one skilled in the art to make a bearing assembly, as taught by Geyer, with the height of the housing in between about 2.5 inches to about 4.5 inches so as to fit in a railcar structure, wherein, the available clearance space for accommodating a bearing assembly in said railcar structure is only in between about 2.5 inches to 4.5 inches.


6. Claims 6-7 and 26-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 13-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 703-308-3663. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Mark T. Le
Primary Examiner
Art Unit 3617

mle
1/27/05